

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Nathanael F. Ehrich, et al.

Serial No.: 10/674,759 Filed: September 30, 2003

For: Autonomic Content Load Balancing

Art Unit: 2153 Examiner: Yasin M. Barqadle

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Final Rejection in the Office Action mailed November 2, 2007 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

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GROUND OF REJECTION PRESENTED FOR REVIEW

The **First Ground of Rejection** presented for review is a rejection of Claims 1 - 2, 4 - 5, and 12 under 35 U.S.C. §102(b) as being anticipated by U. S. Patent 6,842,768 B1 (incorrectly stated as U. S. Patent 6,345,279 in the Office Action) to Shaffer et al. (hereinafter, “Shaffer”), according to the Office Action mailed November 2, 2007 (referred to herein as “the Office Action”) and as further discussed in the Advisory Action mailed January 15, 2008.

The **Second Ground of Rejection** presented for review is a rejection of Claims 6 - 11 under 35 U.S.C. §103(a) as being unpatentable over Shaffer in view of U. S. Patent 5,649,200 to Leblang et al. (hereinafter, “Leblang”).

ARGUMENT

For expediency only, Applicants will discuss independent Claims 1, 10, and 12 and dependent Claim 7 only. Applicants reserve the right to argue additional grounds, and in particular to explicitly argue separate patentability of the other claims, if this Petition is denied.

The **First Ground of Rejection** applies to independent Claims 1 and 12. A finding of anticipation requires, as stated by the Court of Appeals of the Federal Circuit, absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

Referring first to independent Claim 1, this claim recites “defining a plurality of alternative versions of a Web page to be served ...” (Claim 1, line 3, emphasis added). The Office Action cites Shaffer’s **FIG. 6** as teaching this claim language. Applicants respectfully disagree.

The concept of a “Web page” is well known. As defined in Wikipedia¹, “A **Web page** or **webpage** is a resource of information that is suitable for the World Wide Web and can be accessed through a web browser.” (emphasis original).

What is shown in Shaffer’s **FIG. 6** as “alternative versions” is various types of files or messages (see col. 9, lines 10 - 11, “... a list of available files or messages ...”) that are available for downloading using different compression formats (see col. 9, lines 13 - 16, “... for some messages, the invention lists [in the user interface display **400** of **FIG. 6**] a download time as an uncompressed file ... or as a compressed file ... in one or two alternative formats”).

Suppose Shaffer’s user selects the “no compression” version (see the column having reference number **410**) of “Outside Phone Call” listed in the first row of table **400** in **FIG. 6**. In response, this “Outside Phone Call” will be downloaded to the user as an uncompressed Wave File (see the “Wave File” designation under the “SUBJECT” column). However, this uncompressed Wave File is not an alternative version of a Web page. Instead, it is a spoken transmission contained in a file. See col. 4, lines 56 - 57, stating “Once the appropriate file is available, it is transmitted to the user ...” (emphasis added)². Transmitting a “Wave File” to a user is not the same as “serving the selected version of the Web page ...”, as claimed by Applicants on line 8 of Claim 1 (emphasis added).

As another option, suppose Shaffer’s user selects the “no compression” version of “Ext. 613 (Robin Jay)” listed in the second row of table **400** in **FIG. 6**. In response, this “Ext. 613 (Robin Jay)”,

¹See www.wikipedia.org.

²Applicants note that the above-quoted language from col. 4, lines 56 - 57 corresponds to step **A6** of **FIG. 2**; steps **A2 - A6** of **FIG. 6** are cited in the Office Action for the “along with values ...” claim language on lines 3 - 4 of Claim 1. Office Action, p. 4, lines 3 - 5.

which corresponds to a phone call (as denoted by the phone icon at the left margin of this second row of table 400), will be downloaded to the user as a Transcribed Text File (see the “Transcribed Text” designation under the “SUBJECT” column). However, there is no teaching, or any suggestion, that this “Transcribed Text” is a “version of a Web page” (Claim 1, line 3, emphasis added) or that it is served as “the selected version of the Web page” (Claim 1, line 8, emphasis added). Instead, the above-quoted col. 4, lines 56 - 57 of Shaffer are interpreted as transmitting a file to the user, where this transmitted file contains the “Transcribed Text”. Transmitting a file of text to a user is not the same as “serving the selected version of the Web page ...”, as claimed by Applicants on line 8 of Claim 1 (emphasis added).

As yet another option, suppose Shaffer’s user selects the “medium compression” version (see the column having reference number 412) of “Cheryl Crow” listed in the fourth row of table 400 in FIG. 6. In response, this “Cheryl Crow” message, which corresponds to an email message (as denoted by the envelope icon at the left margin of this fourth row of table 400), will be downloaded to the user as an email message. However, there is no teaching, or any suggestion, that this email message is a “version of a Web page” (Claim 1, line 3, emphasis added) or that it is served as “the selected version of the Web page” (Claim 1, line 8, emphasis added). Instead, the above-quoted col. 4, lines 56 - 57 of Shaffer are interpreted as transmitting a file to the user, where this transmitted file contains the email message. Transmitting a file containing an email message to a user is not the same as “serving the selected version of the Web page ...”, as claimed by Applicants on line 8 of Claim 1 (emphasis added).

In none of these examples (which are representative of FIG. 6) does Shaffer download a file that can be “accessed through a web browser”. Therefore, it is clear that none of the clickable links in

FIG. 6 provides an “alternative version of a Web page”³. Accordingly, it can be seen that Shaffer does not disclose, with absolute identity for each and every element, the claim limitations of Applicants’ Claim 1.

Referring next to independent Claim 12, this claim recites “... wherein the content forms a portion of a particular Web page” (Claim 12, lines 5 - 6, emphasis added). The Office Action analyzes Claim 12 using the same citations used for analyzing Claim 1, although the claim language is different in those claims. Accordingly, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of anticipation as to Claim 12. Furthermore, with regard to the “clickable links” used by Shaffer, the alternatively-compressed versions of the content reachable through those links (where this content may be, for example, a “Wave File”, “Transcribed Text”, or email message) do not “form[] a portion of a ... Web page” and that content is not “stor[ed] ... as the content for the portion of the ... Web page”, in contrast to Applicants’ Claim 12, lines 5 - 6 and lines 11 - 12, respectively (emphasis added).

In view of the above, Applicants respectfully submit that their independent Claims 1 and 12 are not anticipated by Shaffer, according to the above-discussed *Trintec Indus.*

The **Second Ground of Rejection** applies to dependent Claim 7 and independent Claim 10. For a finding of obviousness, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added), as stated in Section 2143.03 of the MPEP, “All Claim Limitations Must Be Considered”, quoting *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

³See the above-provided definition of “Web page” from Wikipedia.

Referring first to dependent Claim 7, the Office Action provides no separate discussion of Claim 7, and instead cites portions of Shaffer which were used for rejecting independent Claim 6. These portions of Shaffer were discussed above with regard to Claim 1. Notably, Claim 7 recites "... the content with selectable versions comprises a portion of the Web page" (Claim 7, line 2, emphasis added), and Applicants respectfully submit that Claim 7 is patentable over the references for the same reasons discussed above with regard to analogous claim language from Claim 1 (i.e., "... a plurality of alternative versions of a Web page").

Referring next to independent Claim 10, the Office Action states "this is a computer-implemented system with similar limitations as in claims 6 - 8 above". Office Action, p. 7, lines 13 - 17. Claim 10 recites "... the content comprising at least two different portions, each of which has associated therewith a plurality of alternative versions ..." (Claim 10, lines 4 - 5, emphasis added) and "serve the content using the selected version for each of the different portions ..." (Claim 10, line 11, emphasis added). In other words, a single "content" is served (Claim 10, line 11), and that content "us[es] the selected version for each of the [at least two] different portions" (Claim 10, line 11, referring to antecedent in line 4). Applicants find no teaching, or suggestion, in the citations for any of Claims 6 - 8 that can be equated to this claim language, when considering all of the words recited therein as required by the above-quoted holding from *In re Wilson*.

In view of the above, Applicants respectfully request that the rejections in the Office Action be reversed by the appeal conference prior to the filing of an Appeal Brief.